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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,764	11/25/2003	Stephane Bedard	055722.000100.04USCP	4189
27148 7590 06/23/2009 POL SINELLI SHUGHART PC 700 W. 47TH STREET SUITE 1000 KANSAS CITY, MO 64112-1802				
EXAMINER				
WILLSE, DAVID H				
ART UNIT		PAPER NUMBER		
3738				
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06/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/721,764

Applicant(s)

BEDARD ET AL.

Examiner

David H. Willse

Art Unit

3738

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-11, 14-18, 23-25 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11, 14-18, 23-25, and 35-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The Applicant's remarks have been considered. The Applicant appears to have overlooked the Johnson embodiment of Figure 10 (in conjunction with the electric actuator of Figure 5A), as discussed in the Office action of November 14, 2008, and as further described below. However, in the examiner's view, amending present claim 1 so as to set forth that the "first pivot axis" (line 11) defines a *prosthetic knee joint* axis, or comparable language, would serve to patentably distinguish the instant invention over that of Johnson, because there would have been no reason, suggestion, or motivation for locating the "mechanical knee" (Johnson: column 2, lines 42-44; column 4, lines 15-21) at the hinge connections **606** and/or **618**. Instead, the "mechanical knee" would have been positioned *above* the mounting mechanisms **602** and **604** (column 9, lines 2-4; Figure 10; column 2, lines 42-44; column 4, lines 31-33; column 3, line 67, to column 4, line 2; etc.). The Applicant is encouraged to telephone the examiner at the number below if a further explanation or discussion is needed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 38, line 1, "said a trans-tibial" lacks a proper antecedent basis and is grammatically improper.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-11, 14-18, 23-25, and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, US 6,206,932 B1, which discloses a knee member **604**, **602**, **618** (Figure 10); a socket connector assembly **28** for connecting a *soft* socket (or liner) to the knee member; a trans-tibial member **44**, **12**, **610**; a connector assembly for connecting foot member **19** to the lower end of prosthetic limb **12** (column 4, lines 9-12) or for connecting the lowermost leaf spring member to foot member **19** (Figure 10); a first pivot assembly **606**, **608**; a linear actuator **302** (column 9, lines 26-29; column 6, line 52 et seq.; Figure 5A) comprising a rotary motor **310**, a screw **316**, and a follower **306** (column 7, lines 2-10); a second pivot assembly **616b**; and a third pivot axis **616a**, **620**. Regarding the functional “wherein” clause at the end of present claim 1, attention is directed to MPEP § 2106; moreover, interchanging male and female portions of the threaded coupling such that the rotated element **316** moves “in or out of said follower” (instant claim 1, lines 17-18) would have been an obvious mechanical design variation yielding predictable results quite similar to those obtained from the illustrated embodiment. Regarding the preamble of claim 1, the embodiment of Figures 5A and 10 is functionally *capable* of being used with an above-knee amputation, whether or not such was the intent; additionally, the Johnson mechanism can be specifically adapted for above-knee amputees (column 2, lines 42-44; column 4, lines 15-21), with the mounting adaptor **604** serving as a lower member or base for a *prosthetic* knee joint. A socket connector assembly for connecting a

residual limb socket to the *prosthetic* knee joint would then have been immediately obvious to one of ordinary skill in the art.

The further limitations of claims 3, 5, 6, and 11 would have been obvious in order to shield the actuator **302** and other movable parts from the shell cover **22** (Figure 1) and/or the external environment, with the detachable closure having been obvious in order to access the actuator and other components for maintenance or replacement. Regarding claims 7 and 8, an energy storage module and circuit board supported on the shell would have been obvious in order to render the system more portable, self-contained, and manageable for a physically impaired amputee. Regarding claims 15-18 and 23-25, a controller and sensors were well known in the art and would have obvious for the switching system of Johnson because such elements would provide for fine-tuning the adjustments in the same manner as the wheel **322**, verifying the orientation of the foot via proprioceptors and the like, and modifying the orientation via load sensors or optical sensors, with the ordinary practitioner having been motivated by the innate need to store orientation data corresponding to the various footwear of the amputee (column 1, lines 58-61; column 2, lines 6-12 and 63-67; etc.) and “to change the loading on the knee socket in such a way that it provides less irritation to areas on or around the residual limb” (column 2, lines 60-63; column 1, lines 20-27). Regarding claim 35, the hinge connections **606** and **618** may be U-shaped (column 9, lines 3-5 and 15-17). Regarding claim 38, the hinge connection **610** likewise may be U-shaped (column 9, lines 8-10).

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under

37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. Attention is directed to MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is 571-272-4762 and who is generally available Monday, Tuesday, and Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

**/David H. Willse/
Primary Examiner
Art Unit 3738**